

Customer No.: 31561
Application No.: 10/708,366
Docket No.: 12456-US-PA

REMARKS

Present Status of the Application

The Office Action has rejected claims 1, 2, 3, 12-14, 19, and 20 under 35 U.S.C. 102(b), as being anticipated by Dutcher (US-4,498,581, hereinafter "Dutcher"). The Office Action also rejected claims 4-6, 11, and 20 under 35 U.S.C. 103(a) as being unpatentable over Dutcher. The Office Action has rejected claim 15 under 35 U.S.C. 103(a), as being unpatentable over Dutcher in view of Friedland et al. (US-6,238,762; hereinafter "Friedland"). Claims 7-9 and 16-18 are rejected under 35 USC 103(a) as being unpatentable over Dutcher in view of Cuffey et al. (US-2,967,010, hereinafter "Cuffey").

Applicants respectfully traverse the rejections and amend the claims.

After entry of the foregoing amendments, claims 1-9, 11-14, 16-18, and 20 remain pending in the present application, and reconsideration of those claims is respectfully requested.

Discussion of Rejections Under 35 USC 102(b)

The Office Action has rejected claims 1, 2, 3, 12-14, 19, and 20 under 35 U.S.C. 102(b) as being anticipated by Dutcher (US-4,498,581, hereinafter "Dutcher").

Applicants respectfully submit that independent claims 1 and 12 are allowable for at least the reason that Dutcher fails to teach or disclose each and every feature of the independent claims 1 and 12.

Claims 1 and 12 recite respectively:

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Claim 1. An easily tearable film, comprising a unidirectionally tearable film with a plurality of cutting lines thereon, wherein an adhesive layer for sticking the easily tearable film on an object, wherein the adhesive layer is located on a surface of the unidirectionally tearable film;

the unidirectionally tearable film has a tearing direction; and each cutting line has a first end point and a second end point, and has a joining point with an imaginary straight line parallel to the tearing direction that passes the first end point of a next cutting line.

Claim 12. A method for preparing an easily tearable adhesive film, comprising:
providing a unidirectionally tearable film that has a tearing direction;
forming an adhesive layer on a surface of the unidirectionally tearable film; and
forming a plurality of cutting lines on the unidirectionally tearable film, wherein each cutting line has a first end point and a second end point and has a joining point with an imaginary straight line parallel to the tearing direction that passes the first end point of a next cutting line.

Furthermore, paragraph [0031] of the present invention recites the following:

[0031] On the other hand, a flow chart of preparing an easily tearable film according to this invention is shown in FIG. 5. In step 500, a unidirectionally tearable film having a tearing direction is provided, wherein the examples of the material of the unidirectionally tearable film are described above. The step 500 may be followed by other steps, such as a step of forming an adhesive layer on the surface of the unidirectionally tearable film. **When an adhesive layer is formed on the easily tearable film, it can stick to an object after being torn apart.**

Based upon the description and inherent / implicit teachings of the “adhesive layer” formed on the surface of the easily tearable film in paragraph [0031] in the present invention, especially with respect to the part of “[w]hen an adhesive layer is formed on the easily tearable film, it can stick to an object after being torn apart”, it can be deduced, interpreted, and understood by a person skilled in the art that the above “adhesive layer” is **IMPLICITLY OR INHERENTLY DEFINED in claims 1 and 12**

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to be coated throughout the entire film to be able to then have the described feature of “stick to an object after being torn apart”. This is because if the adhesive is only partially coated in limited regions as shown in FIG. 1 in Dutcher in the form of “adhesive strips 28, 30”, the remaining film will not be able to remain sticking to an object after being torn apart IF when the remaining film included only parts that DO NOT have adhesive strips on them since Dutcher clearly DOES NOT teach explicitly, inherently, or implicitly of coating the entire film with an “adhesive layer”. In other words, a remaining film (due to weight by gravity) will certainly not remain sticking to an object when all of the portion of the film that do indeed contain the adhesive are completely removed.

Applicants submit that claims 1 and 12 patently define over Dutcher for at least the reason that Dutcher fails to disclose at least the features emphasized above. In other words, the “adhesive layer” coated throughout the entire surface of the film in claims 1 and 12 of the present invention is **NOT EQUIVALENT OR THE SAME AS** the “adhesive strip” coated in limited portions as defined in Dutcher.

Discussion of Rejections Under 35 USC 103(a)

The Office Action has rejected claims 4-6, 11, and 20 under 35 U.S.C. 103(a) as being unpatentable over Dutcher. Furthermore, claim 15 is rejected under 35 U.S.C. 103(a), as being unpatentable over Dutcher in view of Friedland et al. (US-6,238,762; hereinafter “Friedland”). Claims 7-9 and 16-18 are rejected under 35 USC 103(a) as being unpatentable over Dutcher in view of Cuffey et al.

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In regards to rejections to claims 4-6, 11, and 20, the "adhesive layer" in claims 1 and 12 as fully described in the previous discussion of rejections under 35 USC 102(b) is also clearly patentable over Dutcher in rejections under 35 USC 103(a) based upon the following traversal below.

MPEP 2143.01 recites the following: "If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious. In re Ratti, 270 F.2d 810, 123 USPQ 349 (CCPA 1959)." The modification of a "adhesive strip" to become an "adhesive layer" to be coated on the entire surfaces of the carton wall panels would be certainly deemed to change the principle of operation of the "adhesive strip" of Dutcher. The original principle of operation of the "adhesive strip" in Dutcher is for the adherence of the top wall panels 18 and 40 together. On the other hand, the principle of operation for the "adhesive layer" in claims 1 and 12 of the present invention is "so that the easily tearable film 100 can stick to an object after it is torn" (as found in paragraph [0027] of the present invention).

Furthermore, MPEP 2144.08 recites the following: "... In re Bell, 991 F.2d 781, 783, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993) ("The PTO bears the burden of establishing a case of prima facie obviousness.")" Indeed, the present application demonstrates nonobviousness over Dutcher in view of Friedland as well as over Dutcher in view of Cuffey.

Based on the above traversal, the teachings of Dutcher are not sufficient to render the claims prima facie obvious, and the rejections to claims 4-6, 11, and 20 should be

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overcome based on the patentability of "adhesive layer" in independent claims 1 and 12. Claims 4-6, 11, and 20, which depend from claims 1 and 12 respectively, are also patentable over Dutcher, at least because of their dependency from an allowable base claim.

Claim 15 is canceled, thus rendering the rejection to claim 15 under 35 U.S.C. 103(a) as being unpatentable over Dutcher in view of Friedland to be moot.

In regards to rejections to claims 7-9 and 16-18, the "adhesive layer" in claims 1 and 12 as fully described in the previous discussion of rejections under 35 USC 102(b) is also clearly patentable over Dutcher in view of Cuffey et al. (US-2,967,010, hereinafter "Cuffey") in rejections under 35 USC 103(a). Neither Dutcher nor Cuffey teaches of the "adhesive layer" found in claims 1 and 12 of the present invention. Claims 7-9 and 16-18, which depend from claims 1 and 12 respectively, are also patentable over Dutcher in view of Cuffey, at least because of their dependency from an allowable base claim.

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CONCLUSION

For at least the foregoing reasons, it is believed that the pending claims 1-9, 11-14, 16-18, and 20 are in proper condition for allowance. If the Examiner believes that a telephone conference would expedite the examination of the above-identified patent application, the Examiner is invited to call the undersigned.

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Respectfully submitted,

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